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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,752	09/15/2003	Rebecca L. Twigg	FSP0028	1547

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EXAMINER

PEACHES, RANDY

ART UNIT	PAPER NUMBER
2617	

DATE MAILED: 08/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/662,752	Applicant(s) TWIGG ET AL.	
	Examiner Randy Peaches	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/10/06 has been entered.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. **Claims 4-22** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over **claims 1-39** of

copending Application No. 10/833,412. Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitations of **claims 4-22** are broad and are encompassed by the limitations of **claims 1-39** of copending Application No. 10/833,412 and as such would have been obvious to one of ordinary skill in the art to implement the invention of the instant application as defined by **claims 4-22** in order to facilitate a means for an efficient process to provide the network with the subscriber identity via a SIM.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Regarding **claims 4, 7 and 20** and its dependent **claims 5-6, 8-10, 12-19 and 21-22** the claims have similar and/or exact limitations as **claims 1, 11 and 21** in that the copending Application No. 10/833,412 details wherein a said device comprises a SIM module capable of receiving identification information about a subscriber from the said device to further transmit this information to the network. The instant application, though the claims are not detailed word-for-word, processes the information in an exact manner.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. ***Claims 4-22*** are rejected under 35 U.S.C. 102(e) as being anticipated by Vuoristo et al. (U.S. Patent Application 6,603,969 B1).

Regarding ***claim 4***, Vuoristo et al. discloses mobile station comprising: device information; and logic which, provides the device information to a SIM, receives from the SIM a communication comprising the device information, and transmits the communication to a network. See column 11 line 33-67 and column 12 lines 25-32.

Regarding ***claim 5***, according to ***claim 4***, Vuoristo et al. discloses a said mobile station comprising: location information. See column 11 lines 36-46; and said signal message (3-1), when applied to the processor, provides the location information to the SIM. See column 11 lines 36-46.

Regarding ***claim 6***, according to ***claim 4***, Vuoristo et al. discloses column 12 lines 34-44. said signaling message (3-1), receives at least one of settings and logic from the

network, and applies the settings and logic to effect configuration.

Regarding **claims 7 and 19**, Vuoristo et al. discloses in column 11 line 33-67 a SIM comprising:

- signaling message (3-1) which receives device information from the terminal device, and, when the terminal device is different than the terminal device used with the previous activation of the SIM (see column 11 lines 33-67), formulates a communication comprising the device information, and causes the communication to be transmitted to a network, based on the subscriber number. See column 6 lines 24-37 and column 1 lines 60-67.

Regarding **claim 8**, according to **claim 7**, Vuoristo et al. discloses a SIM comprising: logic which receives location information from the terminal device, formulates a communication comprising the location information, and causes the communication to be transmitted to a network. See column 11 lines 36-46.

Regarding **claim 9**, according to **claim 7**, Vuoristo et al. discloses a SIM comprising: user information (see column 6 lines 9-12); and logic which, when applied to the processor, formulates a communication comprising the user information, and causes the communication to be transmitted to a network. See column 11 lines 3-27.

Regarding **claim 10**, according to **claim 7**, Vuoristo et al. discloses a SIM comprising:

logic which communicates the device information to the network via at least one of SMS, EMS, and MMS. See column 5 lines 48-58.

Regarding **claim 11**, Vuoristo et al. discloses a network comprising:

- a base station subsystem (BSS). See column 12 lines 1-10;
- subscriber information. See column 11 lines 54-67; and
- logic which, when executed by one or more network elements of the network, locates subscriber data in response to a communication from a terminal device, identifies subscriber services, determines terminal device settings, and communicates the settings to the terminal device. See column 12 lines 1-65.

Regarding **claim 12**, according to **claim 11**, Vuoristo et al. discloses a network further comprising:

- one or more network elements to communicate with the terminal device using one of SMS, EMS, MMS, and SyncML. See column 5 lines 48-58.

Regarding **claim 13**, according to **claim 11**, Vuoristo et al. discloses a network further comprising:

- logic which, when executed, communicates configuration logic to the terminal device.

Regarding **claim 14**, Vuoristo et al. discloses a method comprising:

- in response to activation of a SIM in a terminal device, the SIM requesting device information from the terminal device;
- the device providing the device information to the SIM and ;
- the SIM formulating a communication comprising the device information and causing the communication to be transmitted to a network. See column 6 lines 23-37.

Regarding **claim 15**, according to **claim 14**, Vuoristo et al. discloses a method further comprising:

- the SIM formulating the communication according to one of SMS, EMS, MMS, and SyncML. See column 5 lines 48-58.

Regarding **claim 16**, according to **claim 14**, Vuoristo et al. discloses a method further comprising:

- the device providing location information to the SIM. See column 11 lines 36-46;
- the SIM formulating a communication comprising the location information. See column 11 lines 3-27; and
- the SIM causing the communication to be transmitted to a network. See column 11 lines 36-46.

Regarding **claim 17**, according to **claim 14**, Vuoristo et al. discloses a method further comprising:

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receiving at least one of software, which reads on claimed "settings and logic," from the network and applying the settings and logic to effect communication of the terminal device to receive services from the network. See column 12 lines 34-44.

Regarding **claim 18**, according to **claim 14**, Vuoristo et al. discloses a method further comprising:

- the SIM formulating a communication comprising user information. See column 6 lines 11-15; and
- the SIM causing the communication to be transmitted to a network. See column 11 lines 36-46.

Regarding **claim 20**, Vuoristo et al. discloses a method comprising:

- activating a SIM in a communication device. See column 11 lines 33-53;
- the SIM formulating a communication comprising the location information. See column 11 lines 3-27; and
- the SIM causing the communication to be transmitted to a network. See column 11 lines 36-46.
- the SIM formulating a communication comprising the device information and causing the communication to be transmitted to a network. See column 6 lines 23-37.

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Regarding **claim 21**, according to **claim 20**, Vuoristo et al. discloses a method comprising :

the communicating device communicating the message information and causing the communication to be transmitted to a network. See column 6 lines 23-37.

Regarding **claim 22**, according to **claim 20**, Vuoristo et al. discloses a network further comprising:

one or more network elements to communicate with the terminal device using one of SMS, EMS, MMS, and SyncML. See column 5 lines 48-58.

Response to Arguments


Applicant's arguments with respect to **claims 4-22** have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randy Peaches whose telephone number is (571) 272-7914. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Randy Peaches
August 3, 2006


CHARLES APPIAH
PRIMARY EXAMINER